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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,509	10/31/2003	Robert H. Wollenberg	T-6298B (538-61)	3591

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EXAMINER

JACKSON, ANDRE K

ART UNIT	PAPER NUMBER
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2856

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,509

Applicant(s)

WOLLENBERG ET AL.

Examiner

André K. Jackson

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 19-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 4, 6-12 and 15-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show part 234 as described in the specification (on page 21 last line). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed

of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

On page 16, there are empty lines, which have to be updated ("Serial No:____" and "filed on____").

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the Examiner cannot find anything in the specification which states that all three tests are done sequentially. The only recitation is that two tests are done sequentially hydrodynamic and extreme pressure (Page 23). Clarification s needed.

Election/Restrictions

5. Applicant's election with traverse of invention I (Group I claims 2-18) in the reply filed on 04/04/05 is acknowledged. The traversal is on the ground(s) that there is no burden since all of the inventions are classified within Class 73. This is not found persuasive because the claimed invention, which is filed within the same class, does not mean that there are not multiple inventions within the class. For example, Applicant appears to be arguing that same class means same invention. If such were carried to its logical conclusion there could only be one patent per subclass and Applicants could be denied a patent on the basis that there is already at least one patent in Class 73.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

6. Claims 1,2,13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Boffa et al.

Regarding claim 1, Boffa et al. disclose in the patent entitled "Oil compositions with synthetic base oils" providing a plurality of different lubricating oil composition samples including a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive; measuring wear stability of each sample to provide

wear stability data for each sample and outputting the results of step (Abstract; Column 9, lines 40-61).

Regarding claim 2, Boffa et al. disclose where the step of measuring wear stability is selected from the group consisting of an extreme pressure wear test, hydrodynamic wear test, corrosive wear test and a combination thereof (Column 9).

Regarding claim 13, Boffa et al. disclose where the at least one lubricating oil additive is selected from the group consisting of antioxidants, anti-wear agents, detergents, rust inhibitors, dehazing agents, demulsifying agents, metal deactivating agents, friction modifiers, pour point depressants, antifoaming agents, co-solvents, package compatibilisers, corrosion-inhibitors, ashless dispersants, dyes, extreme pressure agents and mixtures thereof (Column 4, lines 35-65).

Regarding claim 14, Boffa et al. discloses the step of including the step of displacing the plurality of lubricating oil compositions to a testing station configured to provide at least one of the extreme pressure wear stability test, hydrodynamic wear test, and the corrosive wear test to determine anti-wear properties of each of the tested lubricating oil compositions in accordance with the program control (Column 9, Tables 1-3).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boffa et al in view of Holgado et al.

Regarding claim 3, Boffa et al do not disclose where the step of measuring wear stability further comprises the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof. However, Holgado et al. disclose in the patent entitled "Dual purpose hydraulic fluid" where the step of measuring wear stability further includes the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test (Columns 7,8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boffa et al to include where the

step of measuring wear stability further includes the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test.

By adding this feature the apparatus would be able to accurately measure the fluid under differing conditions.

9. Claims 4,6,7-12 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to André K. Jackson whose telephone number is (571) 272-2196. The examiner can normally be reached on Mon.-Thurs. 7AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2856

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.J.

June 09, 2005



HEZRON WILLIAMS
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